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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212768
Party	Plaintiff INTS It Is Not The Same, GmbH
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Attachments	1433-55 Opposer's Reply in Support of its Motion to Amend Pleading.pdf(14220 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/836,544
Published in the Official Gazette on August 27, 2013

INTS It Is Not The Same, GmbH,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91212768
	§	
Disidual Clothing, LLC,	§	
	§	
Applicant.	§	

**OPPOSER'S REPLY IN SUPPORT OF ITS MOTION FOR LEAVE TO AMEND THE
NOTICE OF OPPOSITION**

Opposer, INTS It Is Not The Same, GmbH ("Opposer") hereby moves for an Order granting leave to amend its Notice of Opposition to add an additional grounds upon which to oppose U.S. Application No. 85/836,544 ("Applicant's "DISIDUAL" mark") pursuant to TBMP § 507.02(a). In support of its Motion for Leave, Opposer states as follows:

A Motion for Leave to Amend a Pleading "should be freely given when justice so requires." Opposer seeks leave to amend its pleading to include claims that Applicant's trademark application is *void ab initio*, that Applicant's mark has been abandoned with regard to certain goods, and that Applicant has committed fraud on the USPTO. Opposer was not aware of these three additional claims until after the discovery process was complete. Applicant posits that Opposer's motion is untimely, because "[d]espite the fact that Opposer knew of the basis for its new claims in August 2015, Opposer waited almost seven months to file its Motion to Amend and just two days before its testimony period was scheduled to begin." *See* Applicant's Response to Opposer's Motion for Leave to Amend its Pleading, pg. 2. However, Applicant fails to account for the fact that the proceedings were suspended for several months due to a pending Motion for Summary Judgment. The Board

issued an Order denying that Motion for Summary Judgment on February 17, 2016. Opposer filed its Motion for Leave to Amend the Notice of Opposition promptly thereafter, on March 1, 2016.

Applicant summarily concludes that "Disidual would suffer undue prejudice if Opposer is allowed to amend its Notice of Opposition and add three new claims on the eve of trial." *See* Applicant's Response to Opposer's Motion for Leave to Amend its Pleading, pg. 4. Applicant fails to explain how it would be prejudiced by allowing the Opposer's Amended Notice of Opposition, other than by offering vague and nebulous references to general trial strategy. Furthermore, the cases cited by Applicant purporting to support the position that Applicant would be unduly prejudiced by allowing the Opposer's Amended Notice of Opposition are readily distinguished and not factually analogous.

Applicant first cites *ChaCha Search, Inc. v. Grape Technology Group, Inc.*, in which the Board denied the moving party's request to add a new claim. *Id.* at 4. However, Applicant fails to acknowledge that the claim sought to be added pertained to the "specimen of use that ChaCha filed in the application for the involved registration." *See ChaCha Search, Inc. v. Grape Technology Group, Inc.*, pg. 7 (TTAB 2013). *A fortiori*, as emphasized by the Board, "the facts upon which that ground is based presumably were within Grape's knowledge at the time the counterclaim was filed and it first reviewed and targeted ChaCha's registration." *Id.* (citing *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001)). Conversely, in the case at bar, the facts upon which the new claims are based were not known to Opposer until after receiving Applicant's discovery responses. Applicant also cites *Int'l Finance Corp. v. Bravo Co.*, 64 U.S.P.Q.2d 1597, 2002 WL 1258278 as standing for the proposition that Applicant would suffer prejudice if Opposer was permitted to add a dilution claim long after the close of discovery. *See* Applicant's Response to Opposer's Motion for Leave to Amend its Pleading, pg. 4. Opposer again notes that a dilution claim, which would be

known to Opposer at the time it filed its Notice of Opposition, is wholly different than claims consisting of fraud, abandonment, and *void ab initio* that were not known to Opposer until after receiving Applicant's discovery responses.

It is highly unlikely the Applicant will be prejudiced by Opposer's Motion for Leave to Amend its Pleading. Furthermore, the Board has held that there is generally no prejudice to an Applicant where a motion to amend is filed prior to the start of the trial period. *See Hurley International L.L.C. v. Volta*, 82 U.S.P.Q. 2d 1339, 1341 (T.T.A.B. 2007 (granting motion to amend before the start of trial)); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 U.S.P.Q. 618, 621 (T.T.A.B. 1974) (finding no prejudice where trial period had not yet commenced). Therefore, Opposer respectfully requests the Board issue an Order Granting Opposer's Motion for Leave to Amend its Notice of Opposition.

Respectfully Submitted,

March 25, 2016
Date

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CERTIFICATE OF SERVICE

This is to certify that on March 25, 2016, a true and correct copy of the foregoing document is being sent by regular mail to the following attorney of record for the Applicant:

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